

## REMARKS

Claims 1-3, 5-15, 17-21, 23-27, and 30-31 remain pending in this application.

Claims 4, 16, 22, 28-29 and 32-33 have been canceled without prejudice or disclaimer.

Claims 1, 8, 17-21 and 23, and claims dependent thereon, have been amended to reduce the scope of the claims to conform with the elected invention - by limiting the 1,2-azole ring B to pyrazole, and to more clearly point out what applicants regard as their invention. These amendments are supported in the original disclosure and do not introduce new matter.

### Lack of Unity

Applicants acknowledge that the Office has made its holding of a lack of unity of invention final.

### Rejections - 35 U.S.C. § 112

Claims 1, 8, 12, 14, 15, 18 and 20-30 have been rejected under 35 U.S.C. § 112, second paragraph, as failing to point out what applicants regard as their invention.

1) As to claim 1, the Office noted that Xb and Yb, for example, cannot possibly simultaneously be a bond without any intervening atoms. The Office also questioned the "character" of the recited bond. It is respectfully submitted that the term "bond" for each of the identified symbols is, and would be understood by those skilled in the art as, an expression indicating that the identified moiety is not present. Thus, the exemplified situation where Xb and Yb are both simultaneously "a bond," means and would be understood to mean by those skilled in this art that Ya is directly bonded to the ring C in the recited formula. Similarly, where Xc and Yc were simultaneously "a bond," it means and would be understood to mean by those skilled in the art that -(C=O)- is directly

bonded to ring C in the formula recited in claim 1. Accordingly, this rejection should be withdrawn.

2) The term "hydroxy-protecting group" and "amino-protecting group" are allegedly undefined (claims 1, 8 and 20-30). Applicants disagree, not only because these terms would be understood by those skilled in the art in the context of the claimed invention, but also because terms in a claim are interpreted in light of the specification disclosure that provides, at page 37, line 15 to page 38, line 9 of the specification, for example, representative examples of these groups in the context of the present invention. Nevertheless, in order to expedite examination and allowance of this application, these claims have been amended to specifically recite the representative members of these groups described in the specification. Accordingly, this rejection should be withdrawn.

3. The Office indicates that recitation of the term "salt" fails to point out the intended subject matter, and should indicate that the salt should be pharmaceutically acceptable. Since the terms in a claim are interpreted in light of the specification disclosure, a person skilled in the art would recognize that a compound intended for a pharmaceutical use should be pharmaceutically acceptable. Nevertheless, in order to advance prosecution and allowance of this application, the term "salt" has been amended to recite that the salt is "pharmacologically acceptable" in accordance with the disclosure at page 54, lines 2-7 of the specification, for example. Accordingly, this rejection should be withdrawn.

4) Claim 18 was rejected as indistinct and confusing because it is allegedly not possible to determine if the claimed salt is formed of the compound or of the prodrug of

the compound or of both. While applicants regard the language as originally presented to be clear, claim 18 has been amended in an attempt to improve the clarity of this claim. Accordingly, this rejection should be withdrawn.

5) The Office indicates that the intended use recited in claims 20-30 is not given any patentable weight and renders these claims substantial duplicates of each other. Claims 22, 28 and 29 have been canceled, and the other claims have been amended to be method claims that avoids the arguments relied on to support this rejection. Accordingly, this rejection should be withdrawn.

6) Claims 20, 28 and 29 were rejected because of the recitation of the term "diabetes" and the suggestion that the treatment is a prophylaxis against development of diabetes. Claims 28 and 29 have been canceled, and claim 20 has been amended to delete the "prophylaxis" embodiment and to recite the specific conditions that can be treated in accordance with the disclosure at page 62, lines 8-11 of the specification, for example. Accordingly, this rejection should be withdrawn.

7) The rejection of claim 22 has been rendered moot by cancellation of that claim.

Rejections - 35 U.S.C. § 102

On one hand, the examiner is thanked for the very comprehensive search and examination evidenced by 44 separate rejections applied to one or more of the claims subject to examination. The analysis of each reference and detailed application of the teachings of each document as they are applied to the rejected claims are exemplary and of great assistance to applicants in understanding the position of the Office. The Office action devoted 31 pages to a very detailed explanation of the allegedly relevant

portions of each document, and clearly took a significant amount of time and care to this Office action.

On the other hand, the citation of 44 references in 44 separate rejections, most of which are applied to the same claims is both excessive and unnecessary. As noted in MPEP 904.03, the Office should avoid the citation of an unnecessary number of references. In addition, MPEP 706.02 indicates that prior art rejections should normally be confined strictly to the best available art; merely cumulative rejections should be avoided. No reason was cited, and none is apparent, to justify such an excessive number of rejections.

Fortunately, each of the rejections are avoided by the amendments to the current claims that include the requirement that Yc is C<sub>1-6</sub> alkylene. Accordingly, each of the documents relied on in the rejections on pages 5-36 fail to anticipate the claims under rejection for at least the reason that each fails to teach a compound within the scope of the present claims where Yc is C<sub>1-6</sub> alkylene. Unless a reference teaches each and every limitation of a claim, it cannot anticipate that claim. Accordingly, these rejections should be withdrawn.

Applicants acknowledge and appreciate the indication that claim 17 would be allowable if placed in independent form.

Prompt and favorable reconsideration of this application in view of the amendments and remarks is requested.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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